

/PATRICK RYAN/

Supervisory Patent Examiner, Art Unit 1795 Reply Brief

Appellant's Reply Brief filed on August 22, 2008 has been considered. The application is being forwarded to the Board of Patent Appeals and Interferences for decision. The examiner's reply to appellant's salient arguments filed in the Reply Brief is as follows:

Appellant references pages 15-16 of the specification in an attempt to give meaning to the term "freshly", presently rejected under 35 U.S.C. 112, second paragraph. Appellant submits that "[b]ased on the wetting time limitation of 8 seconds or less, the term "freshly" clearly falls within day 0 of Tables 2 and 3 and thus provides the temporal boundary sought by the Examiner." The examiner disagrees with this interpretation for the following reasons. Firstly, claim 12 recites the following:

12. The separator according to claim 11, where said separator being freshly coated, and said separator being wetted within 8 seconds or less.

It is noted that claim 28, also subject to the same 35 U.S.C. 112, second paragraph rejection, is modeled in a similar if not identical manner. Based on this claim construction, it is clear that there are two separate time periods: 1) the time period for which the separator is "freshly" coated and 2) the time period for which the separator is wetted. The two time periods are separate and distinct. Thus, in interpreting this claim, the second time period is not considered to constrain in any temporal manner the first time period. For this reason, appellant's assertion that, based on the wetting time period of 8 seconds or less, the term "freshly" clearly falls within day 0 is not found persuasive. Additionally, Table II and Table III show electrical resistance and wettability times (respectively) and, contrary to appellant's assertions, do not in any apparent way relate the number of days of storage to the term "freshly coated".

Appellant's citation of *Phillips v. AWH Corp.* is noted. Appellant cites that the claims "must be read in view of the specification of which they are a part." (Reply Brief on page 11) Appellant submits that based on the above cited language it is clear that the function of the specification is to further define the claims as they are presented in an application. Appellant then submits that "the specification does exactly that, it further defines claims 1 and 17 as to the three considerations which must be met for the first surfactant to be acceptable and the two considerations which must be met for the second surfactant to be acceptable." (Reply Brief on page 12) This argument is not persuasive. The heading of MPEP 2111.01 (II) states that "IT IS IMPROPER TO IMPORT CLAIM LIMITATIONS FROM THE SPECIFICATION". "Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004)." Appellant's claims are entirely silent on any considerations that somehow must be met for the combination of the first surfactant and second surfactant to be acceptable. Thus, the examiner maintains that these three considerations have not been imported into the claim limitations as they clearly are not part of the claim.

In response to the prior art rejections, appellant cites the TSM test as established in *KSR Int'l Co. v. Teleflex*. Appellant submits that "[i]n the Examiner's answer on page 17, lines 1-7, the Examiner again discounts the use of the three considerations to be taken into account for the first surfactant and the two considerations to be taken into account for the second surfactant.

This argument may have merit if these considerations were part of the claim. There is absolutely no language in the claims drawn to "a combination of a first surfactant which is (1) inert to the electrolyte, (2) not soluble or readily soluble in the electrolyte, and (3) adherent to the membrane, and a second surfactant which is (1) inert to the electrolyte and (2) increases the wetting speed and stability of the membrane without interfering with long term membrane storage life." (Appeal Brief on page 25) The examiner maintains that it would be improper to import these limitations into the claims for the reasons set forth in the immediately preceding paragraph, and remains committed to the task of interpreting claims in view of the specification without unnecessarily importing limitations from the specification into the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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